

### REMARKS

Applicant thanks Examiner Madeleine Anh Vinh Nguyen for having pointed out the very serious typographical error in claim 1. Applicant apologizes for that error and sincerely regrets the inconvenience that resulted.

Applicant also wishes to thank the Examiner for having indicated that seven claims (4 through 6, 11, and 24 through 26) would be allowable if suitably amended. For reasons that will become clear in the following discussion, Applicant would prefer not to make such amendments now, but respectfully wishes to reserve the right to so amend those claims at a later point in the prosecution of this case.

#### Section 112 rejections

In the Official Action it is said that claim 1 is indefinite. Applicant has corrected the error involved, and believes that the claim is now clear and definite.

#### Section 103 rejections

It is additionally said in the Official Action that nineteen claims are obvious over Borrell, and therefore unpatentable pursuant to Section 103. The third subpart of Section 103, however, requires (emphasis added):

"(c) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the

claimed invention were, at the time the invention was made, owned by the same person . . . ."

Section 102(e) in turn dictates:

"A person shall be entitled to a patent unless —

. . . .

"(e) the invention was described in . . . (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant . . . ."

As will be shown below, Applicant does not agree that the present invention was described by Borrell before the invention by the Applicant; however, based upon the assertion in the Official Action that the invention was so described, then *arguendo* Borrell either does not describe the invention or does satisfy the definition of § 102(e) art for purposes of § 103(c).

Moreover, assuming that the Borrell patent comes under 102(e), then that patent plainly satisfies the requirement of Section 103(c) that his patent (emphasis added) —

"qualifies as prior art only under one or more of subsections (e) . . . ."

This is true because the Borrell patent issued this year, roughly 3½ years after filing of the present application, and hence cannot qualify under 102(a), (b), etc.

The subject matter of the Borrell patent and the present claimed invention were commonly owned at the time of invention. Both inventors for some time before the present invention were in the employ of the common assignee of the patent and the application, Hewlett-Packard Company — and its component Hewlett-Packard Española — and remain so employed now.

Hence the Borrell patent "shall not preclude patentability under" Section 103, or in other words is not a permissible

reference in this case. Applicant therefore respectfully requests that the reference and the rejection be withdrawn.

Even if Borrell were properly cited, however, then the rejection would still be inapposite because Borrell is distinguishable from the present invention. More specifically, according to the Official Action Borrell discloses (see top of page 3 in the Action) —

"within the region the amount of the colorant printed in some pixels is zero".

This limitation, however, is recited in Applicant's claims 1 and 7 as a requirement of the processing method, i. e. a necessary characteristic. In Borrell, by comparison, at least the principal teaching is that proplection can occur only at "locally dense areas," which are found by "e. g. counting neighboring pixels."

This being the case, the most highly preferred form of Borrell's proplection method and system refrains from adding colorant at areas having zero colorant in the input image data. Thus in Borrell's basic teaching, it is not true that "within the [proplection] region the amount of the colorant printed in some pixels is zero".

This "locally dense" condition, based on counting pixels of input image data that do contain dots, appears in Borrell's Abstract (lines 12 and 13), and also e. g. column 9, lines 28 through 31; column 10, line 65, through column 11 line 5; column 11, lines 20 through 24; primarily at column 16, lines 32 through 51; and also column 18, lines 1 through 5.

Other, peripheral portions of Borrell's disclosure may possibly imply presence of some empty pixels within a proplection area. It is surely far from true, however, that presence of such empty pixels is a requirement or necessity of the disclosed method as in the present case. The Applicant respect-

fully submits that Borrell's teachings fail to come up to a clear enabling teaching of Applicant's claimed invention — or of anything close enough to it to activate Section 103 as proposed in the Official Action.

In the Official Action it is also said that several dependent claims are obvious in view of Borrell. That basis for rejection, however, is inapplicable because — as explained above — Borrell is not properly cited in this case

These claims, moreover, all depend from claims that have been shown above to be not obvious over Borrell. With the additional limitations of the dependent claims, they are a *fortiore* not obvious over Borrell.

It is also questionable whether a skilled artisan would come to think of the Applicant's claimed invention, based on familiarity with Borrell. Borrell teaches that "The basic advantage of [his] invention is that intensity range can be stabilized and linearized without addition of data or bandwidth" (column 12, lines 50 through 52, emphasis added).

Borrell's basic objective of linearizing dynamic range is thus wholly different from that of the present Applicant, which is instead eliminating or reducing white- or light-line banding. This is made clear at page 2, line 28, through page 3 line 22; and also at e. g. page 11, lines 14 through 26.

Claim 22 has been amended to positively recite Applicant's antibanding objective, as a step of Applicant's claimed method. As noted just above, this function is not taught at all by Borell. Furthermore it is believed that practice of Borrell's invention as disclosed would fail to even incidentally produce the recited step.

Applicant respectfully wishes to reserve the right to add Borrell or his coinventor personnel, or both, as coinventors

in the present application. As noted in the spec, they are all coworkers.

### Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully request the Examiner's favorable reconsideration and allowance of all the claims now standing in this case.

It is respectfully requested that, should there appear any further obstacle to allowance of the claims herein, the Examiner telephone the undersigned attorney to try to resolve the obstacle.

Respectfully submitted,



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